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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,202	03/02/2004	Jason T. Griffin	13210-27	2011
1059 7590 07/13/2007 BERESKIN AND PARR 40 KING STREET WEST BOX 401 TORONTO, ON M5H 3Y2 CANADA				
			EXAMINER DHARIA, PRABODH M	
			ART UNIT 2629	PAPER NUMBER
			MAIL DATE 07/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/790,202	Applicant(s) GRIFFIN, JASON T.	
	Examiner Prabodh M. Dharia	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6, 7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6 is/are rejected.
- 7) ☒ Claim(s) 7 and 9-11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>05-31-2007</u> . | 6) <input type="checkbox"/> Other: _____ |

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on 05-31-2007 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.
2. **Status:** Please all replies and correspondence should be addressed to examiner's new art unit 2629. Receipt is acknowledged of papers submitted on 05-31-2007 under amendments, which have been placed of record in the file. Claims 1-4,6,7 and 9-11 are pending in this action. Claims 5 and 8 are cancelled.

Response to Amendment

3. The amendments filed 05-31-2007 do not introduces new matter into the disclosure. The added material is supported by the original disclosure. Applicant has amended claims 4,6,7,9-11.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2629

5. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by Tran, Phat H. (US 20020063684 A1).

Regarding Claim 1, Tran, Phat H teaches a method comprising: canceling detection of a rotation downward of a thumbwheel (page 1, paragraph 14, Lines 1-5, paragraphs 3,17) if detection of a depressible input movement of said thumbwheel occurs (page 1, paragraph 15, Lines 7,8, paragraph 16, Lines 1-6, paragraphs 3,17, page 2, paragraph 18, Lines 4-6, paragraph 19, Lines 1-6, paragraph 21, Lines 1-8) within a predetermined time threshold of detection of said rotation downward (page 2, paragraphs 21-24).

Regarding Claim 2, Tran, Phat H teaches predetermined time threshold is approximately 100 milliseconds (page 2, paragraphs 21-24 range is 50-350 ms).

Regarding Claim 3, Tran, Phat H teaches an article having stored thereon instructions, which when executed by a computing platform (page 1, paragraph 3, Lines 1-3, paragraph 14, Lines 1-7, page 3, claim 1, Lines 1,2, teaches hand-held communication device or mobile device with processor to process software with specific platform such as window to execute instruction) result in: canceling detection of a rotation downward of a thumbwheel if detection of a depressible input movement of said thumbwheel occurs within a predetermined time threshold of detection of said rotation downward (page 1, paragraphs 14-17, page 2, paragraphs 17-21).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Griffin et al. (US 20030076292 A1) in view of Tran, Phat H. (US 20020063684 A1).

Regarding Claim 4, Griffin et al. teaches a mobile electronic device (page, 1, paragraph 6, Line 1) comprising: a flat display screen (see figure 7, page 2, paragraph 25, Line 5); a thumbwheel subassembly including a thumbwheel and a switch (page 2, paragraph 24, Lines 2, see figure 6); and a housing having an opening through which said thumbwheel protrudes (page 1, paragraph 17, Lines 1,2,5), and a microprocessor inside said housing (page 2, paragraph 25, Lines 3,4).

However, Griffin et al. fails to teach a processor to compensate for inadvertent rolling of said thumbwheel down by a user while said user pushes said thumbwheel inwards.

However, Tran, Phat H recites and discloses a processor (page 1, paragraph 3, Lines 1-3, paragraph 14, Lines 1-7, and paragraph 17, page 3, claim 1, Lines 1,2, teaches hand-held communication device or mobile device with processor to process software with specific platform such as window to execute instruction) to compensate for inadvertent rolling of said thumbwheel down by a user while said user pushes said thumbwheel inwards (page 1,

paragraphs 14-17, page 2, paragraphs 17-21) and microprocessor (page 1, paragraph 3, Lines 1-3, paragraph 14, Lines 1-7, page 3, claim 1, Lines 1,2, teaches hand-held communication device or mobile device with processor to process software with specific platform such as window to execute instruction) is to canceling detection of a rotation downward of a thumbwheel (page 1, paragraph 14, Lines 1-5) if detection of a depressible input movement of said thumbwheel occurs (page 1, paragraph 15, Lines 7,8, paragraph 16, Lines 1-6, page 2, paragraph 18, Lines 4-6, paragraph 19, Lines 1-6, paragraph 21, Lines 1-8) within a predetermined time threshold of detection of said rotation downward (page 2, paragraphs 21-24).

Thus it would have been obvious to one in the ordinary skill in the art at the time of invention was made to incorporate the teaching of Tran, Phat H in the teaching of Griffin et al. to be able to have a hand held electronic device would detect and monitor overall activities of thumbwheel for a predetermined time threshold of detection of said rotation downward and report to processor to process specific software application.

Regarding Claim 6, Tran, Phat H teaches predetermined time threshold is approximately 100 milliseconds (page 2, paragraphs 21-24 range is 50-350 ms).

Allowable Subject Matter

8. Claims 7,9-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is an examiner's statement of reasons for allowance:

Examiner used Griffin et al. (US 20030076292 A1) to reject claims 7-11 to cover the range of 2-10 degrees of angle movement as Griffin et al. discloses range to be 0-45 degrees. However after further consideration it was determined 0-45 degrees range does include range of 2-10 degrees, however, Griffin et al. fails to show how it will restrict the thumbwheel movement to 2-10 degrees, where instant application claims housing is constructed to restrict the movement of the thumbwheel to 2-10 degrees angle range, therefore Griffin et al. (US 20030076292 A1), extensively searched prior art as well search in PG PUB to fails to recite or disclose the uniquely distinct features of the independent claims limitations below with all the other limitations recited in independent claims:

thumbwheel subassembly is oriented so that a direction of depressible input movement of said thumbwheel, when projected onto a plane substantially parallel to a plane of said flat display screen, is substantially aligned with a direction of a push by a user's thumb or finger that includes a measurable component of downward force at an angle in a range of approximately 2 degrees to approximately 10 degrees with respect to a direction from a first point on a side of said housing having said opening to a second point directly across from said first point on an opposite side of said housing.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue

Art Unit: 2629

fee. Such submissions should be clearly labeled “Comments on Statement of Reasons for Allowance.”

Response to Arguments

10. Applicant's arguments filed 05-31-2007 have been fully considered but they are not persuasive.

Applicant argues cited prior art of Tran, Phat H. do not disclose cancellation and Tran is not directed to a technique to deal with rolling action of the use that are deemed to be inadvertent.

Examiner disagrees, as Tran, Phat H. discloses a traditional thumbwheel communicating to microprocessor via user operation by rotation upwards or downwards with a click (page 1, paragraph 3). Communication device may receive enable or disable message basis of the detection process (page 1, paragraph 17) basis of timeout threshold. Disabling is same as cancellation as click is ignored and no action is taken against the any click, as premature click has not passed test of timeout threshold (page 2, paragraph 21). This is same as rollover of Keys in typical in Keyboard and it is well known to one ordinary skill in the art. Applicant further has failed to distinguish limitation of cancellation from the cited prior arts in the independent claims and also failed to recite per arguments “cancellation is due to rolling action of the user that are deemed to be inadvertent”.

Griffin et al. also teaches a traditional depressible thumbwheel communicating to microprocessor via user operation by rotation upwards or downwards.

Cited Microsoft corporation prior arts and publication Brewer, et al. (US 2005/0088413 A1) teaches a traditional depressible thumbwheel communicating to microprocessor via user operation by rotation upwards or downwards and inhibits (canceling) rolling action of the user that are deemed to be inadvertent.

The cited prior art of Thomason, Graham G. (US 2001/0024191 A1) (US Philip Corp.) discloses the mouse may comprise a further button or buttons, the operation of which is insensitive to mouse movement. In this way, any mouse movement during single or double click operations may be ignored (cancelled) so as to avoid inadvertent dragging actions. A mouse may be provided with as many further buttons as are required to distinguish separate operations in the system. The mouse may also be provided with traditional thumbwheel as well as buttons.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2629

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prabodh M. Dharia whose telephone number is 571-272-7668.

The examiner can normally be reached on M-F 8AM to 5PM.

13. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

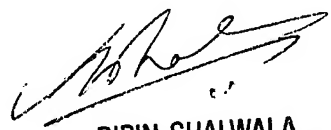
Washington, D.C. 20231

Prabodh Dharia

Partial Signatory Authority

AU 2629

June 28, 2007


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